



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/603,832

06/26/2003

Tokimori Tomita

122.1046CD2

4081

21171 7590 07/14/2010
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

07/14/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/603,832	TOMITA ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 17, 20, 23 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 17, 20, 23 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/3/2010, 2/5/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 4/22/210.
2. Claims 14, 17, 20, 23 and 26 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14, 17, 20, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (6,684,195 hereinafter Deaton) in view of Official Notice.

With respect to claims 14, 17, 20, 23, 26 Deaton teaches a point management system employing a computer for managing points issued to each customer and providing an electronic information service which is available with the customer's cumulative issued points and connected via a communication circuit to a customer terminal for displaying the electronic information (Abstract).

A point issue unit issues points to a customer according to a transaction performed by the customer (see Figure 18B and col. 75, lines 33-38);

a point calculating unit updates the customer's issued points, converts predetermined points into a time period associated with providing the electronic

Art Unit: 3688

information service, and decreases the customer's cumulative issued points according to a time spent for providing the information service in response to the customer's request by redeeming the customer's cumulative issued points (col. 103, lines 52 to col. 104, lines 1-21);

a service providing means for providing the information to a customer (col. 103, lines 64 to col. 104, lines 1-21);

Deaton doesn't specifically teach that the services provided are video information, voice information, software information, music information and database information as the electronic information to the customer through a communication circuit. Official notice is taken that it is old and well known in the computer related arts to provide services electronically such as video information, voice information, software, music and database information to the customer via the customer's PC in order to avoid the need for the customer to having to wait for the goods or services or having to pick up the goods or services from a remote location. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing services/items electronically such as video information, voice information, software, music and database information via his or her PC in order to obtain the above mentioned advantage.

With respect to displaying the electronic information and decreased of points on a customer terminal. Deaton teaches the points are decreased over time (col. 103, lines 52 to col. 104, lines 1-21) and as noted above it is old and well known to receive goods or services electronically. Deaton is silent as to displaying the decreased points

Art Unit: 3688

and information on a customer terminal. Official Notice is taken that it is old and well known for the customer to carry PDA's, cellular or the like to display information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in Deaton the well known teachings of providing information to the customer on a customer terminal to the system of Deaton which decreases the value of points over time because such a modification would allow the customer to receive the information in the convenience of their own terminal.

Response to Arguments

5. Applicant argues that Deaton doesn't teach decreasing predetermined points in proportion to a lapse period of time. The Examiner disagrees with Applicant because Deaton teaches as on col. 103 lines 52-56 "The system may then have a present criteria of response and if that customer meets the preset response criteria, the system may either **maintain that incentive over a preselected time interval or may initially or subsequently reduce that incentive over a preselected time interval.**" As can be seen by the passage above, **the incentives are reduced over a preselected time interval.**

6. Applicant further argues that since Deaton teaches on column 103, lines 63-65 given a \$2 off the shopping visit and if the 85% that the program did not work then increasing their incentive. The Examiner wants to point out that Deaton teaches various incentive programs and that Applicant is concentrating on one portion of Deaton's incentive programs and overlooking other fair teachings. As can be seen by Deaton

Art Unit: 3688

above on col. 103 lines 52-56 Deaton teaches an embodiments wherein the **incentives/ points are reduced based over a preselected time interval.**

7. With respect to the Official Notice taken that the it is old and well known for services provided via video information, voice information, software information, music information and database information and providing the electronic information to the customer through a communication circuit. The Examiner has provided examples of the well known facts and Appellant hasn't provided a proper challenge that would at least cast reasonable doubt that the known facts weren't known prior to Applicant's invention. See MPEP 2144.03.

8. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case , one of ordinary skilled in the art would have the knowledge necessary to know that delivering the information via electronic form would expedite the delivery of the information by avoiding the need for the customer from having to wait for the goods or services or having to pick up the goods or services from a remote location.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571)272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
7/8/2010